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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/985,900	11/06/2001	Glen R. Cataline	47004.000115	4559

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EXAMINER

KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/985,900	Applicant(s) CATALINE ET AL.	
	Examiner Stefano Karmis	Art Unit 3624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/23/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed on 14 November 2005.

Status of Claims

2. Claims 1 and 21-41 are currently amended. Claims 2-20 are originally filed. Claims 42-47 are newly added. Therefore claims 1-47 are under prosecution in this application.

Response to Arguments

3. Applicant's arguments filed on 14 November 2005 has been fully considered but are moot in view of the new grounds of rejection. Therefore claims 1-47 stand rejected and Applicant's request for allowance is respectfully declined.

Terminal Disclaimer

4. The terminal disclaimer filed on 14 November 2005 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of Application No. 10/175,031 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 1-19, 21-39, 41, 43 and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. (hereinafter Dent) U.S. Patent 6,128,603 in view of Kight et al. (hereinafter Kight) U.S. Publication 2002/0062282.

Regarding independent claims 1, 21 and 41, Dent teaches a system for managing transactions comprising:

Art Unit: 3624

a first interface for communicating first information regarding at least one payment source (column 7, lines 3-25);

a second interface for communicating second information regarding at least one payee account (column 7, lines 26-33 and column 7, lines 56 thru column 8, line 2 and Figure 4 and Figure 5);

a processor, communicating with the first interface and the second interface, the processor selectably recommending a transmission of funds from the at least one payment source to the at least one payee account based on an optimization determination (column 5, line 53 thru column 6, line 8 and Figure 2 and column 9, lines 27-31 and column 10, lines 1-14). Dent teaches that the optimization provides a recommendation to the customer to manage cash flows. Dent fails to teach that the processing selectably determines the payment mechanism and the processor effecting the transmission of funds using the payment mechanism. Kight teaches a risk based payment method and system in which the software is designed to make several decisions relating to particular transactions for customers (page 4, paragraph 0030). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the cash flow teachings of Dent and include the teachings of Kight because it allows the system of Dent to automatically perform the recommendation with the cash flow analysis of Kight and therefore maximizes the efficiency of bill payment for a customer while minimizing risk.

Art Unit: 3624

Claims 2 and 22, the optimization determination comprises a calculation of at least one payment source data, payee account data, payment schedule data, payment type data and privacy data (column 9, lines 27-31 and column 10, lines 1-14).

Claims 3 and 23, wherein the at least one payment source comprises a calculation of at least one of a direct deposit account, a source credit account, a mortgage account, a securities account, a money market account, a micro payment account, an overdraft account and a stored value account (column 9, lines 27-31 and column 10, lines 1-14).

Claims 4 and 24, the at least one payee account comprises at least one of a utility account, a mortgage account, a payee credit account and a contribution account (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Claims 5 and 25, a storage module, communicating with the processor, the storage module storing at least one of the data on the optimization determination, data on the at least one payment source account, and data on the at least one payee account (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Claims 6 and 26, wherein at least one of the first interface and the second interface comprises a telephone connection (column 4, line 59 thru column 5, line 3).

Claims 7 and 27, wherein at least one of the first and the second interface comprises a network connection (column 4, line 59 thru column 5, line 3).

Art Unit: 3624

Claims 8 and 28, the network connection comprises a remote client from which a user may communicate transaction instructions (column 4, line 59 thru column 5, line 3).

Claims 9 and 29, the remote client comprises at least one of a computer, a network-enabled cellular telephone, a portable digital assistant, a paging device, and a set-top box (column 4, line 59 thru column 5, line 3).

Claims 10 and 30, the user comprises at least one of a consumer, a business entity and a government entity (column 3, lines 6-26).

Claims 11 and 31, wherein at least one of the first interface and the second interface comprises a desktop graphical user interface directly communicating with the processor (column 5, lines 19-63).

Claims 12 and 32, wherein the processor performs an optimization on a transaction carried out according to the transaction instructions (column 9, lines 27-31 and column 10, lines 1-14).

Claims 13 and 33, the optimization comprises at least one of minimizing a cost variable, fulfilling a transaction schedule, minimizing a payment penalty, maximizing a float of the at least one source account, ensuring an affiliation between the payment source and the payee account, maximizing security, maximizing reliability, minimizing risk, fulfilling a contractual obligation,

Art Unit: 3624

maximizing volume discounts, aggregating a transaction amount, maximizing a transaction amount and maximizing available bonus awards (column 9, lines 27-31 and column 10, lines 1-14).

Claims 14 and 34, Kight teaches that the optimization comprises minimizing a cost variable, and the cost variable comprises at least one of a transaction cost charged to a payment initiator and an internal cost absorbed by a payment enabler (page 2, paragraph 0023 and page 4, paragraphs 0034-0035).

Claims 15 and 35, the optimization determination comprises utilization of third party association and payment providers (column 5, line 53 thru column 6, line 8).

Claims 16 and 36, wherein members of the third party associations are systematically identified by at least one of real time calls to the third party associations, and real time calls to a datastore containing third party association member data which is periodically updated (column 5, line 53 thru column 6, line 8).

Claims 17 and 37, the optimization determination comprises a systematic identification and internal settlement for closed loop payments in which the payment source and the at least one payee account reside within one entity (column 7, lines 56 thru column 8, line 2 and column 9, lines 27-31 and column 10, lines 1-14).

Art Unit: 3624

Claims 18 and 38, wherein an expense reduction resulting from optimization of the cost variable is realized by at least one of the payment enabler and the payment initiator (column 9, lines 27-31 and column 10, lines 1-14).

Claims 19 and 39, wherein a payment initiator is presented with at least two mechanisms that meet the payment schedule data and associated costs of the at least two mechanisms, and the payment initiator is permitted to manually choose an optimal method of transfer (column 10, lines 15-20).

Claim 43, Kight teaches performing the optimization determination comprises aggregating a transaction amount (page 4, paragraphs 0034-0035).

Claim 45, Kight teaches the payment source comprises at least one selected from the group consisting of a checking or other demand deposit account, money market fund, securities account, stored value account, credit card account, currency account, overdraft line of credit, micro payment account and line of credit (page 2, paragraph 0024 and page 3, paragraph 0025).

Claim 46, Kight teaches the processor further performing a second optimization process, the second optimization process selecting the at least payment source from a plurality of payment sources based on the optimization (page 4, paragraph 0033-0034).

Claim 47, wherein the system allows the payment request initiator to select a payment source from a plurality of payment sources (page 3, paragraph 0025 and paragraph 0028).

9. Claims 20 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. (hereinafter Dent) U.S. Patent 6,128,603 in view of Kight et al. (hereinafter Kight) U.S. Publication 2002/0062282 in further view of Boesch et al. (hereinafter Boesch) U.S. Patent 6,205,433.

Claims 20 and 40, Dent and Kight fail to teach that the transmission comprises a currency conversion. Boesch teaches that the customer computer is programmed to choose the currency conversion method that optimizes the transaction without reducing the options available to the customer user (column 11, lines 37-62). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dent and include the optimization teachings of Boesch because it provides a way to minimize cost and optimize cash flows without limiting the user's transaction options.

10. Claims 42 and 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dent et al. (hereinafter Dent) U.S. Patent 6,128,603 in view of Kight et al. (hereinafter Kight) U.S. Publication 2002/0062282 in further view of Cunningham et al. U.S. Patent 6,029,139.

Claims 42 and 44, Dent and Kight fail to teach optimization for volume discounts and contractual minimums. Cunningham teaches an optimization for promotions, which include

Art Unit: 3624

quantifiable inputs such as volume, price, or profit goals. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Dent and Kight to include the teachings of Cunningham because it provides for maximizing efficiency in transactions by optimizing the variables in the transaction.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

Art Unit: 3624

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted

Stefano Karmis

19 April 2006



HANI M. KAZIMI
PRIMARY EXAMINER